

## **REMARKS/ARGUMENTS**

### **Status of the Claims**

Prior to entry of this amendment, claims 11-17, 19-23, and 32-64 were pending in the application. An office action mailed May 23, 2005 rejected claims 17, 19, 38-40, 45-46, 55, 57, and 60 were under 35 U.S.C. § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. The office action also rejected claims 16-17, 19, 33, 37-40, 45-51, 60-61, and 63-64 under 35 U.S.C. § 103(a) as being as being unpatentable over Petruzzi et al (US 6,049,811) ("Petruzzi") in view of Tran (US 2001/0049707) ("Tran").

Claim 52 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Petruzzi and Tran in view of Nagashima et al (US 5,778,398) ("Nagashima"). Claims 53 and 56-57 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Petruzzi and Tran in view of Jammes et al (US 6,484,149) ("Jammes"). Claims 54-55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Petruzzi and Tran in view of Porcari (US 2001/0037460) ("Porcari"). Claims 11-14, 32, 34-36, and 62 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Petruzzi and Tran in view of Lee (US 6,662,178) ("Lee"). Claims 20 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Petruzzi and Tran in view of Takano (US 6,434,580) ("Takano"). Claims 21-23 and 42-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Petruzzi and Tran in view of Hunter (US 6,298,327) ("Hunter").

This amendment amends claims 41, 45, 50, 55 and 60. No claims have been added, or canceled. Hence, after entry of this amendment, claims 11-17, 19-23 and 32-64 stand pending for examination.

### **Information Disclosure Statement**

The applicant appreciates the Examiner's consideration of the Information Disclosure Statement submitted with the applicant's last amendment.

### **Claim Amendments**

Claims 41, 50 and 55 have been amended to correct errors introduced by prior amendments. Specifically, claim 41 has been amended to remove a duplicate instance of the word "the," and claims 50 and 55 have been amended to replace the term "document" with the term "information disclosure statement," to more accurately reflect the subject matter the applicant intends to claim. Claim 50 also has been amended to remove the word "incorporating" to provide additional clarity.

Claim 45 has been amended to recite "providing a computer interface" in one element of the claim and to remove the term "the computer" from additional elements of the claim. Claim 50 has also been amended in similar fashion.

Claim 60 has been amended to recite that the electronic disclosure statement "is configured to meet a set of requirements of the official patent office. It is submitted that the amendment to claim 60 is supported throughout the application, including, inter alia, at lines 23-29 on page 4 of the application. Claim 60 also has been amended to recite an "electronic information disclosure statement," to maintain antecedent basis for that term.

### **§ 112 Rejections**

Claims 17, 19, 38-40, 45-46, 55, 57, and 60 were rejected under 35 U.S.C. § 112, 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Applicants respectfully traverse the rejections and/or submit that the rejections have been overcome by amendments to the claim.

Claim 45 was rejected on the ground that the preamble recites a method but that elements of the claim recite structure. It is believed that the amendments to the claim 45 overcome this rejection.

Claim 46 was rejected on the ground that the claim recites “wherein providing for the transmission of the electronic information disclosure statement to the official patent office comprises printing the electronic information disclosure statement to create an information disclosure statement for mailing to the official patent office.” The rejection under § 112, ¶ 2 notes that “the applicant does not claim any transmission.” This rejection is respectfully traversed. Claim 46, properly construed, merely recites that one procedure in providing for the transmission of the electronic IDS may include printing the electronic IDS. The office action identifies no authority for the proposition that a claim 46 must recite every step in such a procedure, and the rejection of claim 46 therefore is respectfully traversed. For similar reasons, the rejection of claim 57 is traversed.

Claim 55 was rejected in part because the claim recited “inserting into the electronic document a set of information from the linked electronic document.” It is believed that the amendment of claim 55 to recite “inserting into the electronic information disclosure statement a set of information from the linked electronic document” overcomes this portion of the rejection. Claim 55 was further rejected on the ground that “it is unclear how transmission of the statement to the office is accomplished by inserting into the document [now electronic information disclosure statement] a set of information from the linked document.” This portion of the rejection is traversed for reasons similar to those discussed above with respect to the rejections of claims 46 and 57.

Claims 19 and 40 were rejected on the ground that “it is unclear how the computer makes the determination that a patent application is being filed.” The applicant traverses this rejection because it is irrelevant, for the purposes of these claims, how the computer makes that determination. The office action identifies no authority for the proposition that the claims themselves must explain how a particular procedure is performed. There are a variety of ways in which this determination may be made, and claims 19 and 40 read on any of them. Merely by way of example, claim 59 identifies one way in which such a determination may be made.

Claim 60 was rejected on the ground that “it is unclear how a disclosure statement is configured to be filed to fulfill a patent applicant’s duty of disclosure in the official patent office.” It is submitted that the amendments to claim 60 overcome this rejection.

The rejection of claims 17 and 38 queries “where do the instructions come from?” Applicant respectfully submits that this is not a proper rejection under § 112, ¶ 2 and therefore traverse the rejection of these claims. As noted above, there is no authority for the proposition that the claims must explain themselves. That is the purpose of the specification. Merely by way of example, at page 18, line 26 through page 19, line 2, the application describes one exemplary way in which such instructions may be provided. (It should be noted that neither claim 19 nor claim 40, however is limited to the embodiment described in this section of the application.)

Claim 39 is rejected on the ground that “it is unclear how the computer instructs the transmission.” The applicant traverses this rejection and respectfully submits that the rejection represents a misreading of the claim. Claim 39 actually recites, in pertinent part, “computer instructions to electronically transmit the electronic information disclosure statement to a patent office.” That is, the claim does not recite that the computer “instructs” anything. Rather, the claim recites computer instructions (which one skilled in the art would recognize as computer software) that are executable to perform the electronic transmission. The applicant submits that this claim is sufficiently definite to indicate to one skilled in the art the scope of the claimed invention, and that the rejection of this claim should be withdrawn.

For at least the reasons above, the applicant submits that all of the rejections under § 112, ¶ 2 should be withdrawn.

### **§ 103 Rejections**

All pending claims were rejected under § 103(a) as being unpatentable over Petruzzi and Tran, in some cases combined with additional references. The rejections are respectfully traversed, at least because the combination of Petruzzi and Tran fails to teach or

suggest each element of even independent claims 45, 63 and 64. Accordingly, the applicant respectfully requests reconsideration of the claims in light of the arguments herein.

Petruzzi is directed toward a “Machine for Drafting a Patent Application and Process for Doing Same.” In particular, Petruzzi discloses a system that automates the process of drafting a patent application. *See generally* Petruzzi, c. 3, ll. 9-54. Petruzzi discloses that, in one embodiment, the system can be used to prepare “PTO Form 1449 for submitting information in the form of patents, publications, etc. . . . In accordance with an aspect of the invention, a machine and method for preparing an information disclosure statement is provided.” *Id.*, c. 5, ll. 60-65. Petruzzi briefly describes how such an embodiment would function:

“Through the use of a wizard, the operator is prompted for references, a brief description of each reference, and the relevance of each reference with respect to the invention. After the information is inputted, the computer 10 automatically generates a first draft information disclosure statement by adding appropriate phrases and formatting, allowing the operator to complete the information disclosure statement.”

*Id.*, c. 5, l. 67 – c. 6, l. 7. Other than this brief description, Petruzzi does not teach or suggest any additional functionality of its IDS generation tool.

Tran is directed to “Systems and Methods for Generating Intellectual Property,” and more specifically to systems and processes for drafting and electronically filing patent applications. *See generally* Tran, ¶¶ 0016-17. Tran also mentions that such systems can be used to generate an IDS, *id.*, ¶ 0044, and that a pre-filing check verifies that “IDS, if included, lists all art cited by applicant or examiner in any related application and any new art . . .” *Id.*, ¶ 0046. Tran includes no further disclosure of any facility to generate an electronic IDS.

(Incidentally, it should be noted that Tran was filed February 4, 2001. Tran does claim priority to provisional U.S. App. No. 60/185,644 (the “Tran Provisional”), which was filed on February 29, 2000. The present application was filed December 7, 2000, so Tran is not prior art with respect to the present application, except for material disclosed in the Tran Provisional.)

Notably, neither Petruzzi nor Tran teaches or suggests each element of independent claims 45, 63 and 64. Take, for example, claim 45, which recites, inter alia, “providing a computer interface for a user to review at least one electronic document that is relevant to a patent application” and “allowing a user to identify the at least one relevant electronic document for disclosure to a patent office.” Neither Petruzzi nor Tran teach or suggest this element of claim 45. Petruzzi, rather than allowing a user to review an electronic document and identify the document for disclosure, expressly requires the user to enter the reference, along with additional information about the reference, through the use of a data-entry “wizard.” Petruzzi, c. 5, l. 67 – c. 6, l. 7. Nothing in this disclosure teaches or suggests that Petruzzi’s system might provide a computer interface for a user to review at least one electronic document that is relevant to a patent application, or, for that matter, that Petruzzi’s system might allow a user to identify such a document for disclosure (rather than typing in information about the reference, which Petruzzi’s system requires). Tran is silent altogether on how an IDS might be generated and therefore cannot be considered to either teach or suggest these features of claim 45. Hence, it is respectfully submitted that claim 45 is patentably distinct from both Petruzzi and Tran, whether alone or in combination, for at least this reason.

In addition, claim 45 recites “incorporating at least some information from the electronic document into an electronic information disclosure statement,” another element which is neither taught nor suggested by either Petruzzi. Once again, Tran provides no disclosure whatsoever on how its IDS-generation system operates, so Tran cannot possibly teach or suggest this element of claim 45. Further, as described above, Petruzzi, which does not even contemplate the use of electronic documents in creating an IDS, requires the user to enter the relevant information for the IDS into a wizard. In other words, Petruzzi neither teaches nor suggests that information from an electronic document (which Petruzzi does not even mention) might be incorporated into an electronic IDS. For at least this additional reason, the applicant submits that claim 45 is allowable over the cited combination of Tran and Petruzzi.

Likewise, independent claims 63 and 64 are believed to be allowable over the combination of Tran and Petruzzi, for at least reasons similar to those discussed above.

Dependent claims 11-17, 19-23, 32-44 and 46-62 are believed to be allowable as depending from allowable base claims and as being directed to specific novel substitutes.

Merely by way of example, the office action purports to take official notice that “the selection of the relevant document comprising browsing the Internet and finding the document is old and well known” in rejecting claim 48 and that “selecting the relevant document from a database of documents to find at least one relevant document” is well-known. These statement of official notice are respectfully traversed. While browsing the Internet and/or searching a database may be well known as a general matter, the Office Action provides no support for the assertion that the process of allowing a user to select a relevant reference, within an IDS generation system or method, might comprise such functions.

As but another example, Jammes is cited in rejecting claims 53, 56 and 57. It should be noted at the outset that Jammes has absolutely nothing to do with the creation of an IDS and that there appears to be no motivation or suggestion that Jammes, which is directed to creating web pages and viewing product information in an online commerce environment, might be combined with either Tran or Petruzzi, which are directed to entirely different problems altogether.

Claim 53 recites, inter alia, “parsing the at least one electronic document for a relevant portion of a set of reference information.” The office action cites Jammes as teaching this element. The cited portions of Jammes, however, have nothing to do with parsing an electronic document for a relevant portion of a set of reference information. The first passage, c. 7, ll. 15-53 merely provides definitions for the common terms “HTML,” “HTTP” and “CGI” and does not disclose any sort of document parsing, let alone parsing a document for a relevant portion of a set of reference information. Likewise, the second passage, c. 17, l. 62 – c. 18, l. 5, has nothing to do with parsing a document (whether for a relevant portion of a set of reference information or otherwise). Instead, that passage discloses “extract[ing] the query from the HTTP Post message in name/value pair format and pass[ing] the extracted query to ISAPI query

application 354” to process a database query. The applicant fails to see how this possibly teaches or suggests parsing a document (not an HTTP Post message) for a relevant portion of a set of reference information.

Claim 56 recites, “incorporating at least some information from the at least one electronic document into the electronic information disclosure statement comprises storing the at least one electronic document in the electronic information disclosure statement.” The office action asserts that Jammes teaches this element by disclosing the concept of a hyperlink. The applicant respectfully submits that the concept of hyperlinking one document in another, which is well-known, is the antithesis of storing a document in another. The very point of hyperlinking is to provide a reference to a linked document within linking document so that the linked document does not have to be stored in the linking document. Claim 56 therefore is believed to be allowable over the cited references.

Similarly, the cited portions of Jammes fail to teach or suggest the elements of claim 57, which recites “filtering a set of relevant information from the at least one document stored in the electronic information disclosure statement, such that the electronic information disclosure statement comprises the set of relevant information.” As noted above, parsing an HTTP post message reasonably cannot be read to teach or suggest parsing a document for relevant information; nor can it be read to teach or suggest filtering a set of relevant information from a document, such that an electronic IDS comprises the set of relevant information.

Claim 50 provides yet another example. That claim recites, inter alia, that incorporating information for the at least one electronic document comprises “extracting a relevant portion of a set of reference information from the at least one electronic document; and inserting the relevant portion of the set of reference information into the electronic document. information disclosure statement.” The office action asserts that Petruzzi teaches these elements. As noted above, however, Petruzzi does not even teach or suggest that an electronic document might be used in generating an IDS, so it is difficult to see how Petruzzi might teach or suggest extracting a relevant portion of such a document. Petruzzi’s teaching that “the computer 10 automatically generates a first draft information by adding appropriate phrases and formatting”



to the information typed by the user does not teach the extraction of any information from an electronic document, nor the insertion of such information into an electronic IDS. Rather, Petruzzi teaches the opposite—the user provides the relevant information via input to the wizard, and the system provides the formatting and boilerplate phrases. Claim 50 is believed to be allowable for at least this additional reason. Likewise, this portion of Petruzzi fails to teach or suggest the elements of claim 51, which is also believed to be allowable.

Hence, the applicant submits that all claims rejected under § 103(a) are allowable over the cited references, and the applicant therefore respectfully requests the allowance of all pending claims.


### **Conclusion**

In view of the foregoing, the applicant believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

Date: 11-23-05

  
Chad E. King  
Reg. No. 44,187

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 303-571-4000  
Fax: 415-576-0300  
Attachments  
CEK/tnd  
60507097 v1